DRAWINGS

Please replace Figures 1-3 with the replacement sheets that are attached.

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-52 are pending. Claims 1-52 stand rejected. Claims 10-12 and 28 have been objected to.

Claims 1, 8-11, 18, and 28 have been amended. No claims have been cancelled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicant submits that the amendments do not add new matter.

Oath/Declaration

The Examiner stated that the oath/ declaration is defective because, among other things, the full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

Applicant respectfully submits that such statement was issued by error. Please find a copy of the Oath/Declaration that was filed with the Application that has all the requirements including the inventor's full name, mailing address and citizenship.

Drawings

In response to the Examiner's objection with respect to Figures 1-3 Applicant has amended Figures 1-3 to be designated by a legend "Prior Art". A replacement sheet of drawings is attached.

Claim Objections

Claims 8-10 are objected to because of the following informalities: dependent claims 8-10 lack antecedent basis for the phrase "the CODEC". The Examiner states

> Accordingly, all instances of the phrase "the CODEC" in claims 8-10 should be changed to – a CODEC--. Appropriate correction is required.

(p. 3, Office Action 100504)

Applicant has amended claims 8-10 to overcome the Examiner's objection.

Claim 28 is objected to because of the following informalities: the term "output port" should be changed to –input/output port--. The Examiner states

> An output port generally only outputs information. Therefore, by claiming an "output port" to "receive a digital signal", the terminology is inconsistent with the accepted meaning. Appropriate correction is required.

(p. 3, Office Action 100504)

Applicant has amended claim 28 in light of the Examiner's suggestion.

Rejections Under 35 USC § 101

The Examiner has rejected claim 10 under 35 U.S.C. 101 because of the claimed invention is not supported by either a credible asserted utility or a well established utility. The Examiner states

> The conversion of analog sound, speech an/or video to digital code must necessarily occur before any further processing by software. That is, a CODEC that is purely software cannot, in and of itself, perform analog to digital conversion, and must be coupled to a hardware A/D converter to perform the step of analog to digital conversion. Similarly, a software CODEC could not perform the step of converting digital code to analog sound, speech and/or video. The digital to analog conversion must necessarily occur after any processing by the software CODEC in a hardware D/A converter. Accordingly, since the claim is directed only to analog to digital conversion an digital to analog conversion, and not to any further processing steps capable of being performed by software the claim lacks any credible utility.

(p. 4, Office Action 100504)

Applicant has amended claim 10 to overcome the Examiner's rejection under 35 USC § 101.

Rejections Under 35 U.S.C. § 112

The Examiner has rejected claim 10 under 35 U.S.C. § 112, first paragraph. The Examiner has stated that

> Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

(p. 4, Office Action 100504)

Applicant has amended claim 10 to overcome the Examiner's rejection under 35 U.S.C. § 112, first paragraph.

Rejections Under 35 U.S.C. § 102(e)

Claims 1-7, 18, 19 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,675,233 of Du et al. ("Du").

Du discloses an audio controller device to play audio files stored locally on the computer when the computer system is inactive. The audio controller operates in a pass-through mode when the computer system is active. More specifically, Du discloses

> Conversely, when the system is OFF, as depicted in FIG. 2, the MP3 controller of the present invention operates to permit users to traverse the drives 20 and/or 22 to play MP3 files stored therein directly, without requiring that the CPU 12, CPU chipset 14, or audio subsystem 16 be operating. To that end, as shown in this Figure, system power need only be supplied to the controller 18, and to the drives 20, 22.

(Du, Col. 4 Lines 6-12) (emphasis added)

Applicant notes that claim 1 is a method which includes recording audio files to the primary device's storage location while the primary device is in a power saving mode.

Amended claim 1 reads as follows.

A method comprising:
recognizing that a primary device with a storage location has been placed in a power saving mode; and
switching file access control of the primary device's storage location from the primary device to an audio device after the primary device has been placed in a power saving mode; and
recording audio files to the primary device's storage location while the primary device is in the power saving mode.

(Amended claim 1) (emphasis added)

Thus, Du merely discloses a controller playing audio files while the computer system is off. Du, however, fails to disclose, teach, or suggest recording audio files to the primary device's storage location while the primary device is in the power saving mode, as recited in amended claim 1.

Because Du does not set forth all the limitations of amended claim 1, Applicant respectfully submits that amended claim 1 is not anticipated by Du under 35 U.S.C. § 102(e).

Given that claims 2-10 depend, either directly or indirectly, on amended claim 1, Applicant respectfully submits that claims 2-10 are likewise not anticipated by Du under 35 U.S.C. § 102(e).

With respect to claim 18, Applicant has amended claim 18 to specifically indicate that the function of the entry code at the audio device is determined out of a plurality of functions, which includes playing an audio file from the primary device's storage location, recording sound to the primary device's storage location, and providing a karaoke feature while the primary device is in the power saving mode.

Amended claim 18 reads as follows.

A method of processing an audio file located on a primary device's storage location comprising:

accepting a user request at a keypad;

converting the user request to an entry code;

transmitting the entry code to an audio device;

determining the function of the entry code at the audio device;

processing the audio file on the primary device's storage location according to the function determined at the audio device, wherein the function of the entry code is determined out of a plurality of functions, which includes playing an audio file from the primary device's storage location, recording sound to the primary device's storage location, and providing a karaoke feature while the primary device is in the power saving mode.

(Amended claim 18) (emphasis added)

As set forth above, Du merely discloses a controller playing audio files while the computer system is off. Additionally, Du discloses function keys for the controller, which provide various options for playing audio files. More specifically, Du discloses

> Processor 48 is provided to control the general I/O functions, including access, traversal and retrieval commands for drives 20 or 22. In the preferred embodiment, external function keys 66 are provided to permit users to operate controller 18 and drives 20 or 22 to play MP3 files. Function keys can include play, pause, fast forward, rewind, next track, previous track, scan, etc. (or any combination thereof). Since, in the preferred embodiment, the controller 18 of the present invention permits traversal of directory structures and retrieval of files, it is also preferable to include MENU and ENTER function keys 66. Controller 18 includes a function key interface 46 to interpret commands generated by function keys 66 and generate commands to the processor 48.

(Du, col.4, lines 56-67) (emphasis added)

Thus, Du discloses processing the audio file on the primary device's storage location according to a completely different plurality of function keys, which includes play, pause, fast forward, rewind, going to next track or previous track, scanning, or any combination thereof. Du, however, does not disclose processing the audio file on the primary device's storage location according to a plurality of functions of the entry code, which includes playing an audio file from the primary device's storage location, recording sound to the primary device's storage location,

and providing a karaoke feature while the primary device is in the power saving mode, as recited in amended claim 18.

Because Du does not set forth all the limitations of amended claim 18, Applicant respectfully submits that amended claim 18 is not anticipated by Du under 35 U.S.C. § 102(e).

Given that claims 19-27 depend, either directly or indirectly, on amended claim 18, Applicant respectfully submits that claims 19-27 are likewise not anticipated by Du under 35 U.S.C. § 102(e).

Rejections Under 35 U.S.C. § 103(a)

Claims 8, 9, 20, 22-24, 27-34 and 36-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,675,233 of Du et al. ("Du") in view of U.S. Patent No. 6,791,481 of Altare et al. ("Altare").

With respect to claim 1, as set forth above, Du does not disclose, teach, or suggest recording audio files to the primary device's storage location while the primary device is in the power saving mode.

Altare discloses a completely different method performed by a completely different device than claimed by Applicant. Altare discloses a combination of CD-ROM and MP-3 recorder/player, which encodes the analog waveform into MP3-format digital words, writes the MP-3 data first in a buffer memory, and when the buffer memory is filled up, writes the digitized words of MP-3 format to a hard disk of a computer. To conserve power, a hard disk of a computer is powered up only when data is being written to a hard disk and powers down when the data are not being written to the hard disk.

More specifically, Altare discloses

> The MP3 encoded data is passed though the file management unit MPU 31--a custom chip for which may be substituted for purposes of the present invention a microprocessor--first to the buffer Memory 32, which is preferably of the FLASH or DRAM types. When the buffer Memory 32, which is preferably 64K or larger in size, becomes filled, then its contents (such as are then selected for permanent recording) are moved en masse through and by the MPU 31 to the Hard Disk 30, which is preferably of the Winchester type, and is more preferably a magnetic disk of 10 Gbyte or greater capacity.

(Altare, col.12, lines 21-28)

> ...storing so many of the second digital words as represent at least a complete one of the plurality of musical works into a semiconductor memory; and then, when and only when at least one complete musical work is stored in the semiconductor memory, powering up a rotating disk to spin up to recording speed, and recording the at least one complete musical work from the semiconductor memory to the rotating disk, whereupon the rotating disk is powered down...

(Altare, col.14, lines 21-28) (emphasis added)

That is Altare, in contrast, discloses recording digitized audio format data into the hard disk while the hard disk is powered up. Accordingly, Altare does not disclose, teach, or suggest recording audio files to the primary device's storage location while the primary device is in the power saving mode, as recited in amended claim 1.

It is respectfully submitted that Du does not teach or suggest a combination with Altare, and Altare does not teach or suggest a combination with Du. It would be impermissible hindsight, based on Applicant's own disclosure, to combine Du and Altare.

Furthermore, even if Du and Altare were combined, such a combination would lack the limitation of amended claim 1 of recording audio files to the primary device's storage location while the primary device is in the power saving mode.

Therefore, Applicant respectfully submits that amended claim 1 is not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare.

Given that claims 2-10 depend on amended claim 1 and add additional limitations, Applicant respectfully submits that claims 2-10 are likewise not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare.

With respect to claim 18, as set forth above, Du does not disclose processing the audio file on the primary device's storage location according to a plurality of functions of the entry code, which includes playing an audio file from the primary device's storage location, recording sound to the primary device's storage location, and providing a karaoke feature while the primary device is in the power saving mode.

As set forth above, Altare, similarly to Du, does not disclose such limitation of amended claim 18.

It is respectfully submitted that Du does not teach or suggest a combination with Altare, and Altare does not teach or suggest a combination with Du. It would be impermissible hindsight, based on Applicant's own disclosure, to combine Du and Altare.

Consequently, even if Du and Altare were combined, such a combination would lack the limitation of amended claim 18 of processing the audio file on the primary device's storage location according to a plurality of functions of the entry code, which includes playing an audio file from the primary device's storage location, recording sound to the primary device's storage location, and providing a karaoke feature while the primary device is in the power saving mode.

Therefore, Applicant respectfully submits that amended claim 18 is not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare.

Given that claims 19-27 depend on amended claim 18 and add additional limitations, Applicant respectfully submits that claims 19-27 are likewise not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare.

With respect to claim 28, Applicant has amended claim 28 to indicate that a claimed audio device includes a DSP coupled to the gateway, the DSP to read user requested files, decode user requested files, and write to user files when the primary device is in the power saving state.

Amended claim 28 reads as follows.

An apparatus comprising:
a micro-controller;
an input device coupled to the micro-controller, to receive user entries control a primary device's audio device when the primary device is in a power saving state;
an interface to the micro-controller, the interface to provide the micro-controller with access to a storage location, wherein the storage location is coupled to the primary device;
a gateway coupled to the micro-controller;
a DSP coupled to the gateway, the DSP to read user requested files, decode user requested files, and write to user files when the primary device is in the power saving state; and
an input/ output port coupled to the DSP, the output port to transmit a decoded audio stream out of the DSP and receive a digital signal into the DSP.

(Amended claim 28) (emphasis added)

As set forth above, neither Du, nor Altare discloses, teaches, or suggests the limitation of amended claim 28 of a DSP coupled to the gateway, the DSP to read user requested files, decode user requested files, and write to user files when the primary device is in the power saving state.

It is respectfully submitted that Du does not teach or suggest a combination with Altare, and Altare does not teach or suggest a combination with Du. It would be impermissible hindsight, based on Applicant's own disclosure, to combine Du and Altare.

Furthermore, even if Du and Altare were combined, such a combination would lack the limitation of amended claim 28 of a DSP coupled to the gateway, the DSP to read user requested files, decode user requested files, and write to user files when the primary device is in the power saving state.

Therefore, Applicant respectfully submits that amended claim 28 is not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare.

Given that claims 29-52 depend on amended claim 28 and add additional limitations, Applicant respectfully submits that claims 29-52 are likewise not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare.

Claims 11-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,675,233 of Du et al. ("Du") in view of U.S. Patent No. 6,754,895 of Bartel et al. ("Bartel").

With respect to claim 11, Applicant has amended claim 11 to indicate that a claimed method includes searching for updates to the DSP boot program when a format of an audio file changes.

As set forth above, Du discloses an audio device to play audio files stored locally on the computer when the computer system is inactive. More specifically, Du discloses

> Upon user commands generated by the function keys, processor 48 instructs slave IDE interface to control one of the drives to begin traversing the directory structure. The directory structure in which MP3 files are stored by be fixed (for example, a directory may be user-specified and stored in flash memory 52), or the controller can permit users to traverse all directories and files on the drive. Once a user has selected an MP3 file and wishes to play that file (by pressing a play function key, for example), processor 48 instructs the slave IDE interface 54 to retrieve that file from the drive. Preferably, to minimize disk activity once a file selection is obtained, the file is transferred into RAM memory 50. It is most preferable to include dual port SRAM 50, as shown, to store both the audio file and to temporarily store instructions and/or program parameters used by the processor 48. Once the audio file is loaded into memory 50, the data is fed to MP3 decoder circuitry 56.

(Du, Col. 5 Lines 6-22) (emphasis added)

Thus, Du merely discloses traversing audio file directory, retrieving the audio file from the drive, and loading the audio file into the audio device to play the audio file. Du, however, fails to disclose, teach, or suggest searching for updates to the DSP boot program when a format of an audio file changes. , as claimed by Applicant.

The Examiner stated that Du does not disclose searching for updates to the DSP boot program and providing the DSP with updates for the DSP boot program. Additionally, as set

forth above, Du does not disclose searching for updates to the DSP boot program when a format of an audio file changes, as recited in amended claim 11.

Bartel discloses a method of automatically receiving an update application by a handheld device, and executing the update application on the handheld device (Bartel, col. 7, line 64-col.8, line 13). In particular, Bartel discloses that

> In step 604, the update application determines whether a flag has been set in a nonvolatile memory area of PID 12. The flag indicates a previous running of the update application. In step 604, if the update application detects the flag as having been set, process 600 proceeds to step 605, where the execution of the update application terminates. The use of the flag mechanisms saves processor cycles. Upon being initiated, the update application immediately checks for the presence of the flag having been set. This avoids wasting time executing the majority of the update application every time PID 12 is reset. In an alternate embodiment, the update application can be configured to uninstall itself depending upon the condition of the flag.

(Bartel, col.8, lines 13-25) (emphasis added)

Accordingly, Bartel merely discloses determining whether a flag, which indicates previous running of the update application, has been set, and executing the update application if the flag has not been set. Bartel does not disclose a method, which includes searching for updates to the DSP boot program when a format of an audio file changes, as claimed by Applicant.

It is respectfully submitted that Du does not teach or suggest a combination with Bartel, and Bartel does not teach or suggest a combination with Du. It would be impermissible hindsight, based on Applicant's own disclosure, to combine Du and Bartel.

Furthermore, even if Du and Bartel were combined, such a combination would lack the limitation of amended claim 11 of searching for updates to the DSP boot program when a format of an audio file changes.

Therefore, Applicant respectfully submits that amended claim 11 is not obvious under 35 U.S.C. § 103 (a) over Du in view of Bartel.

Given that claims 12-17 depend on amended claim 11 and add additional limitations, Applicant respectfully submits that claims 12-17 are likewise not obvious under 35 U.S.C. § 103 (a) over Du in view of Bartel.

Claims 21 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,675,233 of Du et al. ("Du"), in view of U.S. Patent No. 6,791,481 of Altare et al. ("Altare"), in further view of U.S. Patent No. 6,278,048 of Lee ("Lee").

With respect to independent amended claim 18, as set forth above, neither Du, nor Altare discloses processing the audio file on the primary device's storage location according to a plurality of functions of the entry code, which includes playing an audio file from the primary device's storage location, recording sound to the primary device's storage location, and providing a karaoke feature while the primary device is in the power saving mode.

Lee discloses a portable karaoke device that decodes MP3 audio files, stores the audio files for the accompaniment in the expandable sound module, receives video signal for a background picture, and outputs the voice at the same time the MP3 audio files and video are played. More specifically, Lee discloses

> An MP3 decoder 28 is connected to the ASIC 3 and selectively to a personal computer (PC) 29 to download data about an accompaniment sound and lyrics of a new tune and store the downloaded data in the sound module 1 or other storage unit.

(Lee, col.5, lines 12-16) (emphasis added)

That is, Lee discloses that MP3 decoder is connected to a personal computer to download data about the accompaniment sound and lyrics from the computer. Lee, similarly to Du and Altare, does not disclose, teach, or suggest processing the audio file on the primary device's storage location according to a plurality of functions of the entry code, which includes playing an audio file from the primary device's storage location, recording sound to the primary device's

storage location, and providing a karaoke feature while the primary device is in the power saving mode, as claimed by Applicant.

Furthermore, even if Du, Altare, and Lee were combined, such a combination would lack such limitation of amended claim 18.

Therefore, Applicant respectfully submits that amended claim 18 is not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare and further in view of Lee.

Given that claim 21 depends on amended claim 18 and adds additional limitations, Applicant respectfully submits that claim 21 is likewise not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare and further in view of Lee.

With respect to amended claim 28, as discussed above, neither Du, Altare, nor Lee discloses a DSP coupled to the gateway, the DSP to read user requested files, decode user requested files, and write to user files when the primary device is in the power saving state.

Furthermore, even if Du, Altare, and Lee were combined, such a combination would lack such limitation of amended claim 28.

Therefore, Applicant respectfully submits that amended claim 28 is not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare and further in view of Lee.

Given that claim 35 depends on amended claim 28 and adds additional limitations, Applicant respectfully submits that claim 35 is likewise not obvious under 35 U.S.C. § 103 (a) over Du in view of Altare and further in view of Lee.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If there are any additional charges, please charge Deposit Account No. 02-2666 for any fee deficiency that may be due.

Respectfully submitted,

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Date: 2/7/2005 By: _____

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